

REMARKS

Claim Rejections - 35 USC §102

Claims 1, 2, 4, 5, 9, 11, 12, 14, 15, and 19 are rejected under 35 USC §102(e) as being anticipated by Boudreau et al. (USPN 6,574,399, hereinafter “Boudreau”).

Regarding claims 1, 2, 4, 5, 9, 11, 12, 14, 15, and 19, with regard to Boudreau, it is submitted that Boudreau does not anticipate the Applicants' claimed invention. However, Applicants respectfully submit a Declaration under 37 CFR §1.131 to antedate Boudreau having a filing date of November 2, 2001, which is less than one year prior to the Applicants' effective filing date of January 22, 2002.

Claims 1-5, 8, 9, 11-15, and 18-20 are rejected under 35 USC §102(e) as being anticipated by Ouchi (USPN 6,477,286, hereinafter “Ouchi”).

Ouchi provides an integrated optoelectronic device [6] including an electric circuit unit [1], such as a bare chip of integrated electronic devices, and an optical device unit [2] for performing at least a portion of the input and output of signals to and from the electronic circuit unit via optical signals. The electronic circuit unit [1] and the optical device unit [2] are packaged in a common package with contoured upper, lower and side surfaces, and the optical device unit [2] is provided on a side surface of the package [1,2]. [Ouchi Abstract]

Regarding claims 1 and 11, Applicants respectfully traverse the rejections since the Applicants' claimed combination, as exemplified in claim 1, includes the limitation not disclosed in Ouchi of:

“providing the integrated circuit includes providing photosensitive devices therein for providing feedback for controlling the opto-electronic element...
securing the integrated circuit to the optical substrate” [deletions for clarity]

The support for the amendment is in Specification page 5, lines 14-22:

“A small percentage of that energy is diverted back into the substrate. ... That information is used to control the behavior of the transmitter or light-emitting device 54. This feedback loop allows changing the driving signal

amplitude, its duration as well as its amplitude, depending upon the monitored intensity of the photons, or the optical energy.” [deletion for clarity]

The amendments were previously also supported by amended claims 3 and 13, which previously contained this subject matter.

Ouchi provides for converting between optical and electrical signals but does not disclose providing an integrated circuit comprising photosensitive devices for providing feedback for controlling an opto-electronic element and securing the integrated circuit to the substrate. If the Examiner believes these elements are present in Ouchi, the particular part relied on by column and line numbers is respectfully requested pursuant to 37 CFR §1.104(c)(2).

Constant v. Advanced Micro-Devices, Inc., 7 USPQ2d 1057 at 1064 states:

“A claim is anticipated **only** if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference. (Kalman v Kimberley Clark Corp., 713 Fed. 2nd 760, 771, 218 USPQ 781, 789 (Fed. Circ. 1983), *Cert. Denied*, 465 U.S. 1026 [224 USPQ 520]), 1984.” [bolding added, emphasis in original]

Regarding claims 2-5, 8-9, 12-15, and 18-20, these dependent claims respectively depend from independent claims 1 and 11, and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof.

It is respectfully submitted that the now amended independent claims 1 and 11, and the respective claims 2-5, 8-9, 12-15, and 18-20 depending therefrom, are no longer anticipated by Ouchi taken either singularly under 35 USC §102 and are no longer obvious in combination under 35 USC §103 with the other cited references.

Claim Rejections - 35 USC §103

Claims 6-8, 16-18, and 20 are rejected under 35 USC §103(a) as being unpatentable over Boudreau et al. (USPN 6,574,399, hereinafter “Boudreau”).

Regarding claims 6, 7, 16, and 17, with regard to Boudreau, it is submitted that no combination, including an obvious modification of Boudreau, will render the Applicants’

claimed invention obvious. However, Applicants respectfully submit a Declaration under 37 CFR §1.131 to antedate Boudreau having a filing date of November 2, 2001, which is less than one year prior to the Applicants' effective filing date of January 22, 2002.

Claims 6, 7, 10, 16, and 17 are rejected under 35 USC §103(a) as being unpatentable over Ouchi (USPN 6,477,286, hereinafter "Ouchi").

Regarding claims 6, 7, 10, 16, and 17, these dependent claims respectively depend from independent claims 1 and 11, and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof.

Since Ouchi does not appear to teach or suggest the claimed invention related to the claimed integrated circuit in claims 1 and 11, any such teaching or suggestion would appear to be based on the Examiner's personal knowledge and an Examiner's Affidavit under 37 CFR §1.104(d)(2) is respectfully requested so the knowledge may be traversed.

It is respectfully submitted that the now amended independent claims 1 and 11, and the respective claims 6, 7, 10, 16, and 17 depending therefrom, are no longer obvious based on any obvious modification of Ouchi under 35 USC §103(a).

The other references cited by the Examiner showing the prior art have been considered and are not believed to disclose, teach, or suggest, either singularly or in combination, Applicants' invention as claimed.

Conclusion

In view of the above, it is submitted that the claims are in condition for allowance and reconsideration of the rejections is respectfully requested. Allowance of claims 1-20 at an early date is solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this

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paper, including any extension of time fees, to Deposit Account No. 50-1078 and please credit any excess fees to such deposit account.

Respectfully submitted,



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